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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,077	03/12/2001	James H. Wang	11302-1050 (44040-251536)	3503

23594 7590 01/03/2003

JOHN S. PRATT
KILPATRICK STOCKTON LLP
1100 PEACHTREE
SUITE 2800
ATLANTA, GA 30309

EXAMINER

MULLIS, JEFFREY C

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 01/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/753,077

Applicant(s)

WANG ET AL.

Examiner

Jeffrey C. Mullis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 January 1933.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 3,6,8-11,13 and 21-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7,12,14-20,32 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11. 6) ☐ Other: _____

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All remaining rejections and/or objections follow.

Claims 1, 2, 4, 5, 7, 12, 14-20, 32 and 33 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

The term "water soluble" renders the claims unclear since water solubility is a matter of degree and therefore relative and it cannot therefore be objectively determined what amount of solubility would be embraced by the term "water soluble".

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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d Claims 1, 2, 4, 5, 7, 12, 14-20, 32 and 33 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Avella et al. (CAPLUS AN 1998: 605333).

See the previous Office action at page 4 line 9 et seq.

M Claims 1, 2, 4, 5, 7, 12, 14-20, 32 and 33 are rejected under 35 U.S.C. § 102(b) as being anticipated by Wang et al. (USP 5,952,433).

Wang et al. disclose a blend of HEMA grafted polylactide and polyvinyl alcohol (a water soluble polymer). Note Example 2. Note that polyethylene glycol methacrylate may be used to replace the hydroxyethyl methacrylate at column 6 lines 47-51.

When the reference discloses all the limitations of a claim except a property or function, and the Examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant. Note In re Fitzgerald et al. 619 F. 2d 67, 70, 205 USPQ 594, 596, (CCPA 1980). See MPEP § 2112-2112.02.

Applicants' arguments filed 9-11-02 have been fully considered but they are not deemed to be persuasive.

With regard to the issue of the term "water soluble", the Examiner cannot comment on applicants' Encyclopedia of Polymer Science and Engineering reference since it has not been submitted

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nor have applicants pointed out specifically where the term "water soluble polymers" is clearly defined. Applicants argue that page 21 lines 1-5 of the present application disclose examples of water soluble polymers. While it is very clear that the Examples on page 21 lines 1-5 are embraced by water soluble polymers, it is not clear what other polymers are embraced by the term "water soluble polymers" such as polymers which are slightly less soluble in water than those listed at page 21 lines 1-5 of the instant specification.

With regard to Avella and the rejection under 35 U.S.C. § 102(b), applicants argue that the Polymer Handbook at page 382 of Volume 17 does not disclose that water is a solvent for polymethyl methacrylate. However the same reference also does not disclose that water is a non-solvent for polymethyl methacrylate and furthermore discloses that solids for polymethyl methacrylate include "ethanol/water". Since applicants' claims and specification do not clearly define the term "water soluble" as excluding a certain amount of co-solvent such as ethanol, it would reasonably appear that polymethyl methacrylate is embraced by applicants' definition of water soluble. Unpatented claims are given their broadest reasonable interpretation consistent with the specification and there is nothing in applicants' specification which indicates that applicants do not mean their

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water soluble polymers include those only soluble in water/co-solvent mixtures.

This Office action is not being made FINAL.

Any inquiry concerning this communication should be directed to Jeffrey Mullis at telephone number (703) 308-2820.

J. Mullis:cdc

December 31, 2002

Jeffrey Mullis
Primary Examiner
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